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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SCHWARTZ, JORDAN MARC	

ART UNIT	PAPER NUMBER
2873	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,803

Applicant(s)

MATSUI, AKIHIDE

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The abstract of the disclosure is objected to because it is too long. Specifically, the abstract cannot exceed 150 words and 15 lines and therefore needs to be shortened in length. Correction is required. See MPEP § 608.01(b) and 37 CFR 1.72.

Claim Objections

Claim 7 is objected to for the following reasons. Since the intended meaning could be determined from what is set forth in the specification and Figures 112 rejections were not made but instead these lack of clarity issues are being raised in the following objections.

With respect to claim 7, line 13, the claimed "to regulate refractive power" creates a lack of clarity since "to regulate" implies that the power can vary and also implies that this surface is the only surface correcting the refractive power. For purposes of examination the assumed meaning is "as a surface having corrective refractive power".

Claim Rejections - 35 USC § 112

Claims 4-5 and 7-8 (and dependent claim 9) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 4 and 5 the claimed "step generated on a boundary surface" lacks an antecedent basis and is inconsistent with what is set forth in the specification and figures rendering the claim vague and indefinite. Specifically, if a step is intended as a limitation then it needs to be claimed with greater clarity and specificity. Regardless, from the specification and figures, apparently the prior art lenses have a step while applicant's lenses have smooth surfaces surrounding the small lens. Therefore, the claimed step is inconsistent with the specification and the intended meaning is not clear rendering the claim vague and indefinite. With respect to claim 4, the assumed meaning is "wherein at least a part of a boundary surface in a peripheral edge..." (deleting the claimed "step generated on") and in claim 5, the assumed meaning is "given to a surface constituting the boundary surface of the..." (again deleting the claimed "step generated on").

With respect to claim 7, lines 4-5, the claimed "previously employing a high-refractive resin having a refractive index of not smaller than 1.66" renders the claim vague and indefinite. Specifically, by claiming "high refractive resin" it is not clear if applicant is claiming that the resin is a highly refractive material or if applicant is claiming high refractive index resin (with the latter being the assumed meaning). Furthermore if applicant is claiming "high refractive index resin" then it is not clear what this is adding as an additional limitation since applicant is specifically claiming "having a refractive index of not smaller than 1.66". Furthermore, the term "previously employing" implies that the refractive index was previously high but no longer is i.e. implies that the refractive index has changed which is presumably not applicant's intended meaning

further rendering the claim vague and indefinite. For purposes of examination the assumed meaning of lines 4-5 are "convex surface side is molded from a resin material having a refractive index of not smaller than 1.66...".

With reference to claim 8, the claimed "is formed employing" renders the claim vague and indefinite since it is not clear if an open-ended or closed-ended meaning is intended from this language. Specifically it is not clear if the intended meaning is "comprises an episulfide resin" (the assumed meaning) or "consists of an episulfide resin".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al patent number 5,531,940.

Gupta discloses the limitations therein including the following: a bifocal plastic lens (column 1, lines 6-9, column 4, lines 14-22); comprising a small lens for short range view (Figure 5B, segment "52" and column 9, lines 31-50, the segment as a bifocal segment and therefore it will inherently correct short range vision); comprising a preparatory lens member having the small lens protruding on a convex surface side (Figure 5B, column 9, lines 31-50, carrier lens "56" and "52" combined as the "preparatory lens" or "56", "52" and "51" combined as the preparatory lens with "small

lens" as the bifocal segment "52"); the preparatory lens molded from a resin material having a refractive index of not smaller than 1.66 (column 9, lines 31-50 re molded and column 7, lines 14-16 re refractive index of 1.66 i.e. "not smaller than 1.66"); and another resin is cast and cured to adhere to the surface of the small lens and preparatory lens to be integrated with the preparatory lens (Figure 5B, column 9, lines 31-50, the layered resin composition of Group B as thin coat "58" cast over the small lens and preparatory lens); the entire surface of the small lens is covered by the resin without a protruding surface (Figure 5B, resin layer "58" completely covers the small lens "52"); a concave surface side of the preparatory lens member as a surface having corrective power (column 5, lines 8-16, claim 10); at least a part of the boundary surface in a peripheral edge of the small lens is a curved surface to prevent the boundary from being conspicuous (Figure 5b, the lower portion of segment "52" as the curved surface); the boundary surface having at least one property of claim 5 (column 11, lines 60-64, column 9, lines 31-50 in that if the outer resin layer "58" is a photochromic or an antireflection layer then it will inherently include a boundary surface between itself and the small lens); the resin adhered to the preparatory lens member as dyed (column 11, lines 60-64, column 9, lines 31-50).

Gupta et al discloses as is set forth above but does not specifically disclose the resin layer "58" having a lower refractive index from that of the preparatory lens. However, from the specific materials disclosed, the resin layer "58" could inherently have a lower refractive index depending on the specific resin used for the preparatory lens versus that used for the thin coat layer "58"(column 6, line 34 to column 7, line 11).

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Regardless Gupta et al discloses that the resin compositions and lens perform "can be matched within 0.05 units of one another" (column 7, lines 13-16) but does not specifically disclose the outer coating layer as having a lesser index than that of the preparatory lens with the segment. However, to be within 0.05 units would involve only three possibilities, i.e. to be greater by up to 0.05, to be the same, or to be less by up to 0.05. It has been held that where there are only a finite number of predictable identifiable solutions, it would have been obvious to a person of ordinary skill in the art to try the known options within his or her technical grasp. *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (2007). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the refractive index of the outer thin coating as less than that of the preparatory lens since Gupta et al discloses that the resin compositions and lens perform "can be matched within 0.05 units of one another" which would involve only three possible solutions and since it has been held that where there are only a finite number of predictable identifiable solutions, it would have been obvious to a person of ordinary skill in the art to try the known options within his or her technical grasp for the purpose of using the finite number of solutions to provide a lens coating of improved protection and optical qualities.

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikata patent number 6,769,768 in view of Pandya patent number 6,934,084.

Nishikata discloses the limitations therein including the following: a bifocal plastic lens (abstract); comprising a small lens for short range view (Figures 1 or 2, column 2,

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line 48, small lens "5"); comprising a preparatory lens member having the small lens protruding on a convex surface side (Figures 1 or 2, column 2, lines 48-55, lens matrix "3" as the preparatory lens); the preparatory lens molded from a resin material (column 2, lines 18 and 59-65, the preparatory lens molded from polyurethane); and another resin adhered to the surface of the small lens and preparatory lens to be integrated with the preparatory lens (Figures 1 or 2, column 2, lines 59-65, coating material "8"); the other resin having a lower refractive index compared with the preparatory lens (abstract); the entire surface of the small lens is covered by the resin without a protruding surface (Figures 1 or 2); a concave surface side of the preparatory lens member as a surface having corrective power (column 1, line 50 to column 2, line 17, column 3, line 41 to column 4, line 20); at least a part of the boundary surface in a peripheral edge of the small lens is a curved surface to prevent the boundary from being conspicuous (Figures 1-2). Nishikata discloses as is set forth above but discloses the material "8" applied to the preparatory lens matrix "3" by coating (column 2, lines 59-64) and not by casting and curing as claimed. However, the examiner takes Judicial Notice that casting and curing are a well known alternative method to coating of applying an outer layer to a lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the outer layer "8" of Nishikata as being applied by casting and curing since Nishikata discloses the outer layer being applied by coating and since casting and curing are a well known alternative method to coating of applying an outer layer to a

lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness.

Nishikata discloses as is set forth above including disclosing the lens as a lens for eyeglasses (column 1, line 6) and the preparatory lens formed of polyurethane (column 2, lines 59-65) but does not specifically disclose the refractive index not smaller than 1.66. Pandya teaches that in an optical article which can be used for eyeglasses and which uses a polyurethane material (column 4, lines 36-56) that it is desirable to use a polyurethane material having a refractive index of 1.66 i.e. not smaller than 1.66 for the purpose of providing an optical article of reduced thickness (column 4, lines 36-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the eyeglass lens of Nishikata formed of a polyurethane material having a refractive index not smaller than 1.66, since Nishikata et al discloses the eyeglass lens formed of a polyurethane material and since Pandya teaches that in an optical article which can be used for eyeglasses and which uses a polyurethane material that it is desirable to use a polyurethane material having a refractive index of 1.66 i.e. not smaller than 1.66 for the purpose of providing an optical article of reduced thickness. Furthermore, having a refractive index of 1.66, the outer layer "8" of Nishikata will inherently have a refractive index less than 1.66 this being reasonably based upon Nishikata disclosing the outer layer having a lower refractive index (abstract) and based upon Nishikata disclosing the outer layer formed of an ADC resin which is a known material having a refractive index of about 1.5.

Claims 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikata patent number 6,769,768 in view Kosaka patent number 7,001,974.

Nishikata discloses the limitations therein including the following: a bifocal plastic lens (abstract); comprising a small lens for short range view (Figures 1 or 2, column 2, line 48, small lens "5"); comprising a preparatory lens member having the small lens protruding on a convex surface side (Figures 1 or 2, column 2, lines 48-55, lens matrix "3" as the preparatory lens); the preparatory lens molded from a resin material (column 2, lines 18 and 59-65, the preparatory lens molded from polyurethane); and another resin adhered to the surface of the small lens and preparatory lens to be integrated with the preparatory lens (Figures 1 or 2, column 2, lines 59-65, coating material "8"); the other resin having a lower refractive index compared with the preparatory lens (abstract); the entire surface of the small lens is covered by the resin without a protruding surface (Figures 1 or 2); a concave surface side of the preparatory lens member as a surface having corrective power (column 1, line 50 to column 2, line 17, column 3, line 41 to column 4, line 20); at least a part of the boundary surface in a peripheral edge of the small lens is a curved surface to prevent the boundary from being conspicuous (Figures 1-2). Nishikata discloses as is set forth above but discloses the material "8" applied to the preparatory lens matrix "3" by coating (column 2, lines 59-64) and not by casting and curing as claimed. However, the examiner takes Judicial Notice that casting and curing are a well known alternative method to coating of applying an outer layer to a lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness. Therefore, it would have been

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obvious to a person of ordinary skill in the art at the time the invention was made to have the outer layer "8" of Nishikata as being applied by casting and curing since Nishikata discloses the outer layer being applied by coating and since casting and curing are a well known alternative method to coating of applying an outer layer to a lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness.

Nishikata discloses as is set forth above including disclosing the preparatory lens of the eyeglass formed of a plastic polyurethane material and not of an episulfide resin having a refractive index of not smaller than 1.66 as claimed. Kosaka teaches that when forming plastic eyeglass lenses it is desirable to form the lenses from an episulfide resin material specifically, having a refractive index of not smaller than 1.66, for the purpose of providing a high refractive index plastic lens of improved mechanical strength and impact resistance (abstract, column 4, line 60 to column 5, line 17, column 10, lines 4-9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the plastic eyeglass lenses of Nishikata being comprised of an episulfide material since Kosaka teaches that when forming plastic eyeglass lenses it is desirable to form the lenses from an episulfide resin material for the purpose of providing a high refractive index plastic lens of improved mechanical strength and impact resistance.

Prior Art Citations

Kobayashi et al patent number 6,179,931 is being cited herein as evidence of the examiner's inherency that ADC resin has a refractive index of approximately 1.5 (column 1, line 34).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

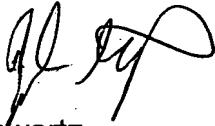
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'J. Schwartz', written over the printed name.

Jordan M. Schwartz

Primary Examiner

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September 21, 2007